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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,447	01/20/2004	Rainer B. Nees	07198.85361-001	3050

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EXAMINER


CANFIELD, ROBERT

ART-UNIT	PAPER NUMBER
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3635

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/761,447	Applicant(s) NEES ET AL.	
	Examiner Robert J Canfield	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

1. This is a first Office action on the merits for application serial number 10/761447 filed 01/20/04. This Office action is in response to the preliminary amendment filed 01/20/04. Claims 1-7 are pending. Claims 8-19 have been canceled.

2. The examiner acknowledges receipt of the IDS received 01/20/04. An initialed copy of the cited references is attached. Note the duplicate citation has been lined out.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "attachment portions" fails to find antecedent basis in the specification. The examiner only finds antecedent basis for end portions.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,668,440 to Bauer et al.

Column 2, lines 60-66 of Bauer provides an intermediate product comprised of a strip of material rolled to have different thicknesses and closed upon itself into circular form with the strip edges 2 and 3 joined by means of a welded seam 4.

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The outer surface has a generally circular cross section and the inner surface a generally non-circular cross section.

Note that "doorbeam" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

6. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,220,277 to Hesse et al.

See the embodiments V and XI in Figure 5. Also note that "vehicle doorbeam" has not been given patentable weight.

7. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,557,961 to Ni et al.

See at least the embodiments of Figures 5 and 6. Also note that "vehicle doorbeam" has not been given patentable weight.

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8. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,494,209 to Randlett et al.

See figures 9 and 11. Approximately half of the web has a different thickness.

The outer surface is circular and the inner surface is non-circular. Welds 31 and 62 are provided at the seams. Also note that "vehicle doorbeam" has not been given patentable weight.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,085,829 to Rogers.

Rogers provides beams comprised of a one-piece, unitary deformable web "A" having a cross section of different thicknesses as shown in figure 2. The web is closed upon itself and lateral edges are welded as shown in figure 3.

The ends of the beam itself form attachment portions.

Rogers fails to provide that approximately half of the cross section has a first thickness and approximately half has a second thickness different from the first thickness.

Rogers suggests at column 2 of page 1, line 41 and lines 15 and 16 of page 2 that any desired widths and thicknesses to form beams of various dimensions may be provided.

This would suggest to one of ordinary skill in the art that for example the beam shown in figure 3 could have been made as a square beam rather than rectangular as shown. A square beam having thickened top 7 and bottom 8 would meet the limitation approximately half of the cross section has a first thickness and approximately half has a second thickness different from the first thickness.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the beam of Rogers could have been made square as suggest by varying the dimensions to form a desired beam.

Note that "vehicle doorbeam" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J Canfield whose telephone number is 703-308-2482. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield
Primary Examiner
Art Unit 3635



09/01/04